

**C. APPLICANT'S COMMENTS**

Claims 1-9 have been canceled, with Claims 10-19 still pending in this Application. No new matter is added by way of these amendments, and the amendments are supported throughout the Specification and the drawings. Reconsideration of Claims 10-19 is respectfully requested.

The Examiner's rejections will be considered in the order of their occurrence in the Official Action.

**Paragraph 1 of the Official Action**

***i. Overview***

The Official Action rejected Claims 1-9 under 35 U.S.C. §103(a) as being unpatentable over Clevett (U.S. Patent No. 2,832,116) in view of Boden (U.S. Patent No. 6,189,186). The Applicant respectfully disagrees with this rejection of these claims, particularly as the same are now amended.

In proceedings before the United States Patent and Trademark Office, the Examiner bears the burden of establishing a prima facie case of obviousness based upon the prior art. *In re Bell*, 26 USPQ2d 1529, 1530 (Fed. Cir. 1993). *In re Oetiker*, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). When references cited by the Examiner fail to establish a prima facie case of obviousness, the rejection is improper and will be overturned upon appeal. *In re Fine*, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985).

"To establish a prima facie case of obviousness, three basic criteria must be met." MPEP §706.02(j). First, there must be some **suggestion or motivation**, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a **reasonable expectation of success**. Finally, the prior art reference (or references when combined) **must teach or suggest all the claim limitations**. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

The law regarding *obviousness* is clear -- any modification of the prior art must be suggested or motivated by the prior art. It is submitted that combining elements from different prior art references (in an attempt to establish obviousness) must be motivated or suggested by the prior art.

'Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so.' [citation omitted] Although couched in terms of combined teachings found in the prior art, the same inquiry must be carried out in the context of a purported obvious "modification" of the prior art. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.

*In re Fritch*, 972 F.2d 1260; 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992), (in part quoting from *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577; 221 USPQ 929, 933 (Fed. Cir. 1984)).

It is also submitted that the mere fact that one may argue that the prior art is capable of being modified to achieve a claimed structure does not by itself make the claimed structure obvious -- there must be a motivation provided by the prior art.

The examiner finds the claimed shape would have been obvious urging that (our emphasis) "it is obvious for one skilled in the art to form each hook base of any desired shape \*\*\* since *this is within the capabilities of such a person*." Thus, the examiner equates that which is within the

capabilities of one skilled in the art with obviousness. Such is not the law. There is nothing in the statutes or the case law which makes "that which is within the capabilities of one skilled in the art" synonymous with obviousness.

The examiner provides no reason why, absent the instant disclosure, one of ordinary skill in the art would be motivated to change the shape of the coil hooks of Hancock or the German patent and we can conceive of no reason.

*Ex parte Gerlach and Woerner*, 212 USPQ 471 (PTO Bd. App. 1980) (emphasis in original).

**ii. Independent Claim 11 (Method Claim)**

Independent Claim 11 has the following features:

11. (Original) A method of securing a file binder about a file, said file binder comprised of an elastic loop member, a bead member attached to said loop member, and a locking member slidably positioned about said loop member, wherein said locking member frictionally engages said loop member for allowing reduction or enlargement of an opening within said loop member and wherein said locking member is positioned between said bead member and a distal portion of said loop member, said method comprising the steps of:

- (g) **providing a file containing one or more documents within;**
- (h) **positioning said loop member about said file;**
- (i) grasping said bead member and said locking member;
- (j) **separating said bead member and said locking member causing said locking member to slide downwardly upon said loop member thereby tightening said loop member upon said file;**
- (k) terminating said separating after a desired contraction force is applied to said file by said loop member; and
- (l) **repeating steps (b) through (e) if another loop member is desired to be secured about said file.**

These steps and functionality are simply not shown in any of the prior art reference cited in the Official Action (nor are they addressed in the Official Action). It appears that the Official Action is rejecting independent Claim 11 because "Clevett, Jr., et al. is inherently capable of performing all of the claimed functions of the present invention." This simply is not correct.

First, there is **no suggestion or motivation**, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the Clevett (or to combine reference teachings). More particularly, Clevett is designed as a “bag closure fastener” that extends through a plurality of eyelets about a perimeter of a bag opening (See Figure 1 of Clevett). There simply is no motivation or suggestion with Clevett (or Boden) to position the loop member about a file with a plurality of loose documents within for binding the file. See also the discussion below regarding independent Claim 10.

Second, there is **no reasonable expectation of success**. If one skilled in the art were to attempt to use Clevett with respect to the present invention, they would have to completely remove the drawstring from the bag and then secure drawstring about the file to be bound. The elastic loop member ensures that the file is bound snugly without damaging sensitive documents within the file. The drawstring in Clevett is non-elastic would have to be tightly drawn on the file and would probably result in damage to the file (and the documents within) because of the amount of force that would have to be applied to ensure that the loop member would not loosen over time from the file and fall off.

Finally, Clevett does **not teach or suggest all the claim limitations** in independent Claim 11. For example, Clevett does **not** teach or suggest “*providing a file containing one or more documents*”. Also, Clevett does **not** teach or suggest “*positioning said loop member about said file*”. In addition, Clevett does **not** teach “*separating said bead member and said locking member .... thereby tightening said loop member upon said file*”. Finally, Clevett does **not** teach “*repeating steps (b) through (e) if another loop member is desired to be secured about said file.*”<sup>1</sup>

For these reasons, among others, the combination of Clevett with Boden cannot suggest the combination of features in applicant’s Claims 11-19, and it is therefore

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<sup>1</sup> It should also be noted that neither Boden nor Buettell teach any of these features.

submitted that the rejection against these claims should be withdrawn and Claims 11-19 allowed.

### **Paragraph 2 of the Official Action**

The Official Action rejected Claim 10 under 35 U.S.C. §103(a) as being unpatentable over Clevett (U.S. Patent No. 2,832,116) in view of Boden (U.S. Patent No. 6,189,186) and Buettell (U.S. Patent NO. 6,675,446). The Applicant respectfully disagrees with this rejection of these claims, particularly as the same are now amended.

Claim 10 has the following features:

10. (Original) A file binding system, comprising:
  - an **elastic loop member**;
  - a **bead member** attached to said loop member; and
  - a **locking member slidably positioned about said loop member**, wherein said locking member frictionally engages said loop member for allowing reduction or enlargement of an opening within said loop member and wherein said locking member is positioned between said bead member and a distal portion of said loop member;
  - wherein said locking member is comprised of a **ring structure** with an aperture;
  - wherein said aperture is sized to frictionally receive said loop member;
  - wherein said loop member is comprised of a **solid loop structure**;
  - wherein said bead member is comprised of a **spherical structure**;
  - wherein said bead member is **larger** than said locking member;
  - wherein said loop member is comprised of an **elastic flat band structure**;
  - wherein said loop member is comprised of a flexible stretchable fabric with interwoven strands of elastic material.

With respect to Claim 10, there simply is **no suggestion or motivation**, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify Clevett (or even to combine reference teachings). More particularly, Clevett is a "**bag closure fastener**" that provides a closure of the "**drawstring**

type which may be automatically locked in closed position.” (Column 1, Lines 20-21). There simply is no reason, motivation or suggestion with Clevett to have a loop member constructed of an “elastic material”.<sup>2</sup> This is a significant feature of Claim 10 and the present invention as it allows for the tensioning about a folder without damaging the contents.

Second, there is **no reasonable expectation of success** of combining Clevett with Boden. There is no suggestion or motivation to combine these references. In addition, even if the elastic material of Boden were incorporated into Clevett, a loop structure capable of being utilized for securing a folder would not be created as shown in the application drawings and claimed in independent Claim 10.

Finally, the prior art references when combined do **not teach or suggest all the claim limitations within Claim 10**. More particularly, none of the cited references disclose “**wherein said bead member is larger than said locking member**”. Also, none of the cited references disclose “**wherein said loop member is comprised of a solid loop structure**”.

For these reasons, among others, the combination of Clevett with Boden and Buettell cannot suggest the combination of features in applicant’s Claim 10, particularly as the same is now amended, and it is therefore submitted that the rejection against this claim should be withdrawn and Claim 10 allowed.

#### **Clevett, Boden and Buettell are Non-Analogous to the Present Invention**

The Applicant respectfully submits that all of the prior art references are non-analogous to the present invention. None of the prior art references cited by the Official Action are within the “**file binding**” area.

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<sup>2</sup> The entire purpose of a drawstring as a bag closure as in Clevett is to “close” the opening and therefore requires the drawstring to be constructed of a non-elastic material to avoid accidental opening of the bag opening. An elastic drawstring simply would not provide the security required to keep a bag closed.

“The determination that a reference is from a non-analogous art is . . . twofold. First, we decide if the reference is **within the field of the inventor’s endeavor**. If it is not, we proceed to determine whether the reference is **reasonably pertinent to the particular problem with which the inventor was involved.**” *In re Wood*, 202 USPQ 171, 174 (C.C.P.A. 1979). “A reference is **reasonably pertinent** if . . . it is one which, because of the matter with which it deals, logically would have commended itself to the inventor’s attention in considering his problem. . . . If a reference disclosure has the same purpose as the claimed invention, the reference relates to the same problem, . . . [i]f it is directed to a different purpose, the inventor would accordingly have had less motivation or occasion to consider it.” *In re Clay*, 23 USPQ 2d 1058, 1060–61 (Fed. Cir. 1992).

First, none of the prior art references cited (Clevett, Boden, Buettell) are within the field of the inventor’s endeavor (i.e. “*file binding*”). Second, none of the prior art references are reasonably pertinent to the particular problem with which the inventor was involved (i.e. *binding files with loose documents in a secure manner*). Hence, the cited prior art references are non-analogous and should not be considered in determining the patentability of the present invention.

The Applicant also respectfully submits the following case law in support that the prior art stated in the Official Action is non-analogous:

- “In resolving the question of obviousness under 35 USC 103, we presume full knowledge by the inventor of all the prior art in the field of his endeavor. However, with regard to prior art outside the field of his endeavor, we only presume knowledge from those arts reasonably pertinent to the particular problem with which the inventor was involved. . . . The rationale behind this rule precluding rejections based on combination of teachings of references from nonanalogous arts is the realization that an inventor could not possibly be aware of every teaching in every art.” *In re Wood*, 202 USPQ 171, 174 (C.C.P.A. 1979).
- “In the instant application, the examiner has done little more than cite references to show that one or more elements or subcombinations thereof, when each is viewed in a vacuum, is known. The claimed invention, however, is clearly directed to a combination of elements. That is to say, appellant does not claim

that he has invented one or more new elements but has presented claims to a new combination of elements. To support the conclusion that the claimed combination is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed combination or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references. . . . Based upon the record before us, we are convinced that the artisan would not have found it obvious to selectively pick and choose elements or concepts from the various references so as to arrive at the claimed invention without using the claims as a guide. It is to be noted that simplicity and hindsight are not proper criteria for resolving the issue of obviousness.” Ex parte Clapp, 227 USPQ 972, 973 (B.P.A.I. 1985).

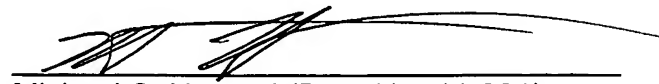
- “We have reminded ourselves and the PTO that it is necessary to consider “the reality of the circumstances” . . . —in other words, common sense—in deciding in which fields a person of ordinary skill would reasonably be expected to look for a solution to the problem facing the inventor.” In re Oetiker, 24 USPQ 2d 1443, 1446 (Fed. Cir. 1992).
- “The Allen-Bradley art is not in the same field of endeavor as the claimed subject matter merely because it relates to memories. It involves memory circuits in which modules of varying sizes may be added or replaced; in contrast, the subject patents teach compact modular memories. . . . Wang’s SIMMs were designed to provide compact computer memory with minimum size, low cost, easy repairability, and easy expandability. . . . In contrast, the Allen-Bradley patent relates to a memory circuit for a larger, more costly industrial controller. . . . Thus, there is substantial evidence in the record to support a finding that the Allen-Bradley prior art is not reasonably pertinent and is not analogous.” Wang Labs., Inc. v. Toshiba Corp., 26 USPQ 2d 1767, 1773 (Fed. Cir. 1993).

#### **D. CONCLUSION**

In light of the foregoing amendments and remarks, early reconsideration and allowance of this application are most courteously solicited. Should the Examiner consider necessary or desirable any formal changes anywhere in the specification, claims and/or drawing, then it is respectfully asked that such changes be made by Examiner’s Amendment, if the Examiner feels this would facilitate passage of the case to issuance. Alternatively should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, they are invited to telephone the undersigned.



Respectfully submitted,



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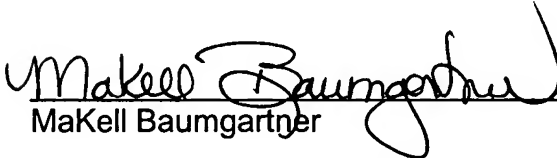
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